

REMARKS

This Amendment is in response to the Office Action mailed on September 9, 2005 in which claims 1-9, 11, 13-17, 20, 21, 23-27, 29-36, 38-42, 61-65, and 67-69 were rejected. With this Amendment, claims 1, 3, 5, 7, 11-15, 17-18, 21-25, 27-30, 32, 39, 61, and 68-70 are amended, and claims 2, 4, 16, 19-20, 26, 31, 35, 42, 44-60, and 67 are cancelled without prejudice. Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

I. Election/Restriction Requirement

On page 2 of the Office Action, the Examiner indicated that claims 10, 12, 18-19, 22, 28, 37, 43-60, 66, and 70 are withdrawn as being directed to a nonelected invention, species or subspecies. With this Amendment, Applicants have cancelled non-elected claims 19 and 43-60. The remaining withdrawn claims are dependent claims that Applicants wishes to have considered upon allowance of their corresponding non-withdrawn generic independent claims, which are still pending in the present application. Certain of the withdrawn dependent claims have been amended in accordance with other amendments discussed below.

II. Rejection of Claims 1-5 and 9 Under 35 U.S.C. § 102(e) Based Upon Berry et al.

On page 2 of the Office Action, the Examiner rejected Claims 1-5 and 9 under 35 U.S.C. § 102(b) as anticipated by Berry et al., U.S. Publication No. 2005/0060034. In response to the rejection, Applicant has attached hereto a Declaration of Prior Invention under 37 C.F.R. § 1.131 that establishes invention of the subject matter of claims 1-5 and 9 prior to September 15, 2003, the filing date of the Berry et al. reference. In particular, claims 1-5 and 9 of the present application read on the embodiments of the invention shown in the drawings of Exhibit A of the Declaration of Prior Invention. Further, the Declaration of Prior Invention provides facts in evidence of various steps taken between September 15, 2003 and the filing date of the present application to establish diligence between September 15, 2003 and constructive reduction to practice of the present invention. In view of the Declaration of Prior Invention removing the Berry et al. reference from consideration with respect to at least

claims 1-5 and 9, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-5 and 9 under 35 U.S.C. § 102(e).

III. Rejection of Claims 1-3, 5-6, and 8-9 Under 35 U.S.C. § 102(b) as Anticipated by Main et al.

On page 3 of the Office Action, the Examiner rejected claims 1-3, 5-6, and 8-9 under 35 U.S.C. § 102(b) as anticipated by Main et al., U.S. Patent No. 4,932,975. In response to the rejection, Applicants have amended claim 1 to include the subject matter of dependent claim 4, which the Examiner has not rejected in view of Main et al. Applicant has cancelled dependent claims 2 and 4 accordingly. In view of the amendment to independent claim 1, Applicant respectfully requests reconsideration and allowance of independent claim 1 and corresponding dependent claims 3, 5-6, and 8-9.

IV. Rejection of Claims 11, 13-17, 20-21, 23-27, 29-36, 38-42, and 61-62 Under 35 U.S.C. § 102(b) as Anticipated by Rabbe et al.

On page 3 of the Office Action, the Examiner rejected claims 11, 13-17, 20-21, 23-27, 29-36, 38-42, and 61-62 under 35 U.S.C. § 102(b) as anticipated by Rabbe et al., U.S. Patent No. 5,702,453. In particular, the Examiner noted that the rejected claims do not positively recite the disc prosthesis. With this Amendment, Applicant has amended independent claims 11, 21, 32, 39, and 61 to positively recite the disc prosthesis. Further, Applicant has amended independent claim 11 to include the subject matter of dependent claim 16; independent claim 21 to include the subject matter of dependent claim 26; independent claim 32 to include the subject matter of dependent claim 35; independent claim 39 to include the subject matter of dependent claim 42; and independent claim 61 to include the subject matter of dependent claim 67. Note that Applicant has amended the language added to independent claims 32 and 39 to recite “a screw retainer” instead of “a pedicle screw retainer.” Applicant has cancelled dependent claims 16, 19-20, 26, 31, 35, 42, and 67 without prejudice. In view of the above amendments, Applicant submits that Rabbe et al. does not anticipate claims 11, 13-15, 17, 21, 23-25, 27, 29-30, 32-34, 36, 38-41, and 61-62 and therefore presents those claims for reconsideration and allowance.

V. Rejection of Claims 61-65 Under 35 U.S.C. § 102(b) as Anticipated by Strnad et al.

On page 3 of the Office Action, the Examiner rejected claims 61-65 under 35 U.S.C. § 102(b) as anticipated by Strnad et al., but indicated that U.S. Patent No. 5,702,453 forms the basis of the rejection. The patent number listed by the Examiner appears to be in error as it corresponds to the Rabbe et al. reference used in the prior rejection. Applicant believes that the rejection of claims 61-65 may be based upon Strnad et al., U.S. Patent No. 6,296,665. However, Applicant wishes to note that U.S. Patent No. 6,296,665 does not appear to be listed on any information disclosure statement submitted by Applicant or the search performed by the Examiner. Accordingly, Applicant requests that the Examiner list the Strnad et al. reference on a Notice of References Cited for documentation purposes. Regarding the merits of the rejection, Applicant has amended claim 61 to include the subject matter of dependent claim 67, which is not rejected by the Examiner in view of Strnad et al. Applicant has cancelled claims 67. Accordingly, Applicant requests reconsideration and allowance of independent claim 61 and corresponding dependent claims 62-65. Applicant has cancelled claim 67.

VI. Rejection of Claims 7, 61, and 67-69 Under 35 U.S.C. § 103(a) Based Upon Berry et al.

On page 4 of the Office Action, the Examiner rejected claims 7, 61, and 67-69 under 35 U.S.C. § 103(a) as unpatentable over Berry et al., U.S. Publication No. 2005/0060034. Applicants have attached hereto a Declaration of Prior Invention under 35 C.F.R. § 1.131 that establishes invention of the subject matter of claims 7, 61, and 67-69 prior to the effective date of the Berry et al. reference. The Declaration of Prior Invention removes the Berry et al. reference from consideration and therefore Applicant respectfully requests reconsideration and allowance of claim 7 (which has been converted into independent format), claim 61 (which has been amended to include the subject matter of dependent claim 67), and claims 68-69, both of which have been amended to depend from independent claim 61.

VII. Conclusion

Claims 1, 3, 5-15, 17-18, 21-25, 27-30, 32-34, 36-41, 43, 61-66, and 68-70 are pending in the present application. Claims 2, 4, 16, 19-20, 26, 31, 35, 42, 44-60, and 67 have been cancelled. Claims 10, 12, 18, 22, 28, 37, 43, 66, and 70 are presently withdrawn. Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application, as amended, is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

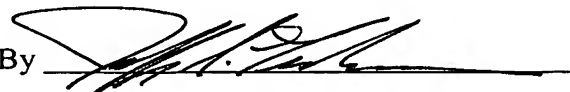
The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date

11/9/05

By



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